

REMARKS

Claims 1-5 and 9 are pending in the present application, and are rejected.

Claim Rejections - 35 U.S.C. §112

Claims 1-5 and 9 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite.

The Examiner asserts that claim 1 is indefinite because the negative limitation “wherein an aqueous polymeric material *not* including a fluorocarbon resin” (emphasis added) is an attempt to claim the invention by “excluding what the inventors did not invent rather than distinctly and particularly pointing out what they did invent.”

Applicants strongly disagree with this statement, and submit that negative limitations are specifically allowed as noted in the MPEP.

Applicants note that the Examiner refers to MPEP §2173.05(i) Negative Limitations, which section recites:

The current view of the courts is that there is *nothing inherently ambiguous or uncertain* about a negative limitation. So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. §112, second paragraph. (Emphasis added).

The MPEP further reads:

Some older cases were critical of negative limitations because they tended to define the invention in terms of what it was not, rather than pointing out the invention.

As an example of one of the “older cases”, the MPEP cites In re Schechter, 205 F.2d 185, 98 USPQ 144 (CCPA 1953), which case appears to be the source of the Examiner’s rejection. However, Applicants note that in that particular case, the limitation “R is an alkenyl radical other than 2-butenyl and 2,4-pentadienyl” was a negative limitation that claimed an entire class of alkenyl radicals with the sole exception of the two alkenyl radicals found by the examiner in the prior art. There had been no specific support for the negative limitation in the specification.

Consistent with the above case, the MPEP specifically notes that a claim containing a negative limitation *that does not have basis in the original disclosure* should be rejected under 35 U.S.C. §112 as failing to comply with the written description requirement. However, the section clearly infers that a claim containing a clearly defined negative limitation that *does* have basis in the original disclosure *should not be rejected* under 35 U.S.C. 112. (Emphasis added).

In the present case, the specification as filed clearly recites that the aqueous polymeric material that is applied to the electrode does not include a fluorocarbon resin. The reason for the exclusion of the fluorocarbon resin may be found in the specification on page 5, last paragraph, which recites that,

Further, compared with a conventional case where a coating layer composed of fluorocarbon resin is provided, an alkaline electrolyte is fully impregnated with hydrogen absorbing alloy powder through the coating layer, and contact between each hydrogen absorbing alloy powder is stably maintained over a long period. As a result, charge/discharge cycle performance of the alkaline storage battery is sufficiently improved, and the ion conductivity of the hydrogen absorbing alloy electrode is increased, resulting in a rise in output of the battery. Further, a rise in internal pressure due to gas generation during overcharging is sufficiently prevented.”

Because the negative limitation is clearly defined and is supported in the specification, Applicants submit that this rejection is incorrect. Applicants traverse this rejection.

Claim Rejections - 35 U.S.C. §102

Claims 1-5 and 9 are rejected under 35 U.S.C. §102(b) as being anticipated by Yuasa et al. (U.S. Patent No. 5,250,369).

Applicants respectfully disagree with the rejection, because not all of the claimed limitations are taught or even suggested by the cited reference.

Applicants note that the Examiner apparently discounted Applicant's prior argument that Yuasa contains an FEP coating, in contrast with claim 1 clearly reciting that an aqueous polymeric material not including a fluorocarbon resin is applied to the electrode to form a coating layer. The Examiner asserts that Applicants' use of the term "composed of" is not exclusive, and could still include a fluorocarbon resin.

Applicants strongly disagree, and submit that according to the MPEP, the phrase "composed of" can mean "consisting of" or "consisting essentially of", depending on the case. Section 2111.03 of the MPEP, Transitional Phrases, instructs that, "The transitional phrase "composed of" has been interpreted in the same manner as either "consisting of" or "consisting essentially of," depending on the facts of the particular case."

Therefore, the broadest reasonable interpretation of the phrase "composed of" is "consisting essentially of", which would exclude all materials that could materially affect the claimed composition.

Applicants note that even if the term “composed of” were read as not exclusive, the phrase still only applies to the binding material of the electrode, but *not* the material coated thereon, which is specifically recited as “*not including a fluorocarbon resin.*” Therefore, Yuasa et al. can not be accurately said to teach all the claimed limitations.

The Examiner asserts that although Applicants claim “an aqueous polymeric material”, the hydrophobic FEP of the cited reference is still read upon by the claim because Applicants do not stipulate the degree of aqueousness.

Applicants respectfully disagree with this rejection and traverse it. Applicants note that the term “aqueous” is understood by those in the art to mean “more aqueous than non-aqueous”, rather than “100% aqueous”. Therefore, the degree of aqueousness, i.e., more than 50%, is implied.

Applicants submit that the hydrophobic polymer dispersed in water of the cited reference could not in any event satisfy the present claims, and could not be considered an “aqueous polymer.” Applicants note that EP 1,199,326A2 refers to an aqueous polymer composition comprised of a *hydrophobic* polymer in an aqueous solvent, which leaves a water insoluble coating when dried.

Claim Rejections - 35 U.S.C. §103

Claims 1-5 and 9 are rejected under 35 U.S.C. §103(a) as being unpatentable over Yuasa et al. (U.S. Patent No. 5,250,369) in view of Kinoshita et al. (U.S. Patent No. 5,527,638).

The Examiner asserts that it would have been obvious to use the specific aqueous polymeric material “coating layer” of Kinoshita et al. on the electrode of Yuasa et al. because Kinoshita et al. discloses that a small decrease in the capacity of the battery configured with the electrode attributable to the repetition of the charging and discharging processes and an excellent cycle life are advantageous features obtained by adding a styrene-butadiene copolymer resin in the mixture “coating the electrode”.

Applicants disagree with this rejection and traverse it, because even if properly combined the cited combination still would not suggest all the claimed elements.

Applicants submit that they have already established that Yuasa et al. does not satisfy the claimed limitation of an aqueous material not including a fluorocarbon resin being applied to an electrode, the electrode comprised of a hydrogen alloy powder and a binding agent on a current collector. Applicants admit that Kinoshita teaches a styrene-butadiene resin; however, Kinoshita et al. does not teach the aqueous resin “coating” the electrode, as asserted by the Examiner. Rather, the styrene-butadiene resin is part of the electrode, and is actually the binder.

Applicants specifically note the passage at column 3, lines 1-12 in Kinoshita et al., which discloses that the styrene-butadiene copolymer resin is actually the binder and the mixture of the styrene-butadiene copolymer resin and the hydrogen storage alloy is supported on a punched or perforated metal. This is different from an aqueous material not including a fluorocarbon resin being applied to an electrode that includes a binder. Therefore, even if properly combined, there is no teaching or suggestion to create the claimed invention.

Application No. 09/893,703
Group Art Unit: 1745

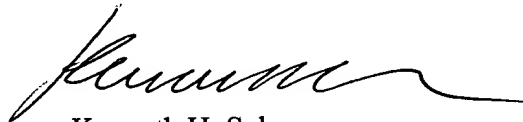
Response under 37 C.F.R. §1.111
Attorney Docket No. 010829

In view of the aforementioned amendments and accompanying remarks, Applicants submit that the claims, as herein amended, are in condition for allowance. Applicants request such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,
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